

DEC 06 2006

Serial No. 10/027,607

Docket No. NG(MS)7191

REMARKS

Claims 1 and 3-20 are currently pending in the subject application, and are presently under consideration. Claims 1 and 3-20 are rejected. Favorable reconsideration of the application is requested in view of the comments herein.

I. Rejection of Claims 1 and 3-20 Under 35 U.S.C. §103(a)

Claims 1 and 3-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2003/0005291 to Burn ("Burn") in view of U.S. Patent No. 6,490,367 to Carlsson, et al. ("Carlsson"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

In rejecting the claims, the Examiner appears to be contending that a certificate, as disclosed in the cited art, can correspond to a token, as recited in the claims. Applicant's representative respectfully disagrees. The term token is clearly defined in the Specification of the present Application. The Specification states that a token is a smart card, a universal serial bus (USB) token, or other hardware token capable of generating, storing, and using public key infrastructure (PKI) certificates/public keys (See Spec., Para. [0018]). Clearly, from the definition of a token as disclosed in the Specification, as well as the normal meaning of a token by a person of ordinary skill in the art, a certificate does not correspond to a token, as recited in the claims.

Furthermore, the Federal Circuit has held that the doctrine of claim differentiation dictates that where claims use different terms, those differences are presumed to reflect a difference in the scope of the claims. *Forest Laboratories, Inc. v. Abbott Laboratories*, 239 F.3d 1305, 1310, 57 USPQ2d 1794 (Fed. Cir. 2001). As an example, claims 7 and 17 both recite storing a signature certificate/private key for the user in a token. Thus, the claims, by virtue of the doctrine of claim differentiation, distinguish between a token and a certificate. Therefore, both the doctrine of claim differentiation and the Specification of the present Application support a conclusion that a certificate does not correspond to a token, as recited in the claims.

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Moreover, regarding claim 1, Burn taken in view of Carlsson does not teach or suggest reviewing, by a Tokenizing Officer, credentials of a user and forwarding the user ID number and the token ID number to a Certificate Management System (CMS) along with an electronic form request and a signature of the Tokenizing Officer, wherein the Tokenizing Officer comprises a person, as recited in claim 1. In the rejection of claim 1, the Examiner contends that Carlsson discloses this element of claim 1. Specifically, the Examiner contends that the certificate issuing process disclosed in Carlsson reads on the reviewing and forwarding performed by the Tokenizing Officer recited in claim 1 (See Office Action, Page 5, citing Col. 8, Lines 12-51 of Carlsson). Applicant's representative respectfully disagrees with the Examiner's contention. Carlsson discloses that an administrator uses a certificate authority (CA) terminal to complete a form with user information and validity periods which are required in order to create a certificate (See Carlsson, Col. 8, Lines 27-30). Carlsson also discloses that a card can be personalized, and that card personalization involves adding a certificate and a user's private key to the card. However, Carlsson does not teach or suggest a Tokenizing Officer forwarding a user ID number and a token ID number to a CMS, as recited in claim 1. In fact, nothing in Carlsson discloses that the cards even contain a token ID number, or some other kind of unique identifier.

In the present Office Action, the Examiner contends that Carlsson disclosure of a sequence number reads on the token ID number recited in claim 1 (See Office Action, Page 2, citing Col. 8, Lines 34-37 of Carlsson). Applicant's representative respectfully disagrees. The cited section of Carlsson discloses that before certificate data is sent to a CA centre, the certificate data is signed, together with the service life and sequence number of the certificate request, by the administrator (See Carlsson, Col. 8, Lines 34-37). The "sequence number" disclosed in Carlsson is clearly referencing an administration number. Nothing in Carlsson teaches or suggest that the sequence number is unique to a card (i.e. token), like the token ID number recited in claim 1. Instead, it appears that the sequence number is unique to the particular certificate request. As stated above, a certificate does not correspond to a token. Accordingly, Burn taken in view of Carlsson fails to teach or suggest reviewing, by a Tokenizing Officer, credentials of the user and forwarding the user ID number and the token ID number to a

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CMS system along with an electronic form request and a signature of the Tokenizing Officer, wherein the Tokenizing Officer comprises a person, as recited in claim 1. Thus, Burn taken in view of Carlsson does not teach or suggest each and every element of claim 1. Therefore, Burn taken in view of Carlsson does not make claim 1 obvious, and claim 1 should be patentable over the cited art.

Claims 3-11 depend either directly or indirectly from claim 1, and are not made obvious by the cited art for at least the same reasons as claim 1, and for the specific elements recited therein. Accordingly, claims 3-11 should be patentable over the cited art.

Additionally, regarding claim 3, Applicant's representative agrees that Burn does not teach or suggest that binding comprises a CMS checking for redundant tokens and revoking any such tokens, as recited in claim 3. However, the Examiner contends that Carlsson makes up for the deficiencies of Burn. In rejecting claim 3, the Examiner has cited Carlsson's disclosure of its certificate revocation procedure (See Office Action, Pages 5-6, Citing Carlsson, Col. 9, lines 14-20). Carlsson discloses that a certificate can be revoked when a user has died, has been found to be unreliable or his/her role has changed (See Col. 9, Lines 14-17). However, the process cited in claim 3 ensures that a user possesses, at most, one token. Nothing in Carlsson teaches or suggests limiting the number of personalized cards (i.e. tokens) that any one user can possess. Moreover, in the present rejection, the Examiner contends that a certificate, as disclosed in Carlsson reads on a token recited in claim 3 (See Office Action, Page 3). For the reasons stated above, a certificate does not correspond to a token, as recited in the claim 3. Therefore, Burn taken in view of Carlsson fails to teach or suggest each and every element of claim 3.

Regarding claim 11, Burn taken in view Carlsson fails to teach or suggest that a Tokenizing Officer utilizes a terminal in a badging facility to forward a unique ID number of the user to which a particular token is to be issued along with a unique ID number of the particular token to a CMS, wherein the Tokenizing Officer comprises a person, as recited in claim 11. As stated above with respect to claim 1, Burn taken in view of Carlsson does not teach or suggest a Tokenizing Officer utilizing a terminal to forward a unique ID of a particular token to a CMS, as recited in claim 11. Accordingly, Burn taken in view of Carlsson does not teach or suggest each

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and every element of claim 11. Thus, Burn taken in view of Carlsson does not make claim 11 obvious, and claim 11 should be patentable over the cited art.

Claims 12-20 depend either directly or indirectly from claim 12, and are not made obvious by the cited art for at least the same reasons as claim 12, and for the specific elements recited therein. Accordingly, claims 12-20 should be patentable over the cited art.

Additionally, claim 13 recites that a CMS checks for redundant tokens and revokes any such user tokens. In the system recited in claim 13, each user can possess, at most, one token. As stated above with respect to claim 3, Burn taken in view of Carlsson does not teach or suggest that a user cannot possess more than one personalized card (i.e. token). Therefore, Burn taken in view of Carlsson does not teach or suggest each and every element of claim 13.

For the reasons described above, claims 1 and 3-20 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

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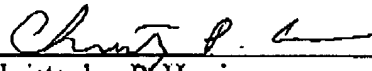
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CONCLUSION

In view of the foregoing remarks, Applicant's representative respectfully submits that the present application is in condition for allowance. Applicant's representative respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

Date 12-06-06

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